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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,031

03/07/2006

Maria Jose Fernandez

4258-117

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23448

7590

03/30/2009

INTELLECTUAL PROPERTY / TECHNOLOGY LAW

PO BOX 14329

RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

WESTERBERG, NISSA M

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

03/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/563,031	Applicant(s) FERNANDEZ ET AL.	
	Examiner Nissa M. Westerberg	Art Unit 1618	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1 - 17.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☒ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). 12/23/08, 4 sheets
 13. ☐ Other: _____.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

/Nissa M Westerberg/
Examiner, Art Unit 1618

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not sufficient to overcome the rejections made in the Final Rejection mailed October 20, 2009. Applicant presents evidence regarding the properties of the products made in the instant application and the properties of those made by the purposed of the cited prior art. These data are not submitted in the form of a Declaration under 37 CFR 1.132 and therefore are only arguments. Therefore, the Examiner is unable to afford sufficient weight to the data presented in order to withdraw the rejection of claims 12 – 17 under 35 USC 102(b) as being anticipated by Grandfils et al. (US 5,962,566). It is also noted that this data is not timely presented, as these claims were first rejected over the same reference in the Office Action mailed March 27, 2008 and the rejection over the product-by-process claims was maintained in the Final Rejection mailed October 20, 2008.

In regards to the rejection of claims 1 – 17 under 35 USC 103(a) as being unpatentable over Grandfils (US 5,962,566) in view of Levy et al. (WO 96/20698), Applicant has argued that the Office action fails to notice that the method put forth in Levy requires two additional steps and the need for additional steps would certainly not appeal to a skilled person in the search of a simpler method for the production of nanoparticles. Additionally, the nature of the active ingredient between the two references and there is no basis for the assumption that the skilled person would have combined the teachings of these two references.

These arguments are not found to be persuasive. Applicant's arguments that one would be deterred by the additional steps is not persuasive as the claims of the instant application are open to additional steps and therefore the additional steps recited by Levy are not excluded. The lipophilic or hydrophilic nature of the active ingredient involves indicating in which phase the active ingredient is dissolved in, both Grandfils and Levy are drawn to methods of making nanoparticles by precipitation of a dissolved polymer by addition to a solution in which the polymer is insoluble.

As noted on the IDS, the statement has not been considered as the IDS was filed after mailing of final rejection and as such, a fee under 37 CFR 1.17(p) AND a statement under 37 CFR 1.97(e) are both required. Only the fee has been paid and therefore the contents of the information disclosure statement have not been considered.